

## REMARKS

This Response is submitted in reply to the Office Action dated May 18, 2004. Claims 32 and 35 stand allowed. Claims 1, 17, 31, and 34 have been amended. No new matter has been added by these amendments.

A Petition for a Two-Month Extension of Time to respond to the Office Action is submitted herewith. A check in the amount of \$450.00 is submitted herewith to cover the cost of the Extension. Please charge Deposit Account No. 02-1818 for any insufficiency of payment or credit for any overpayment.

The Office Action rejected claims 4 and 31 under 35. U.S.C. § 112.

Regarding the rejection of Claim 4, the Figures 5A to 11B of the application clearly show that after the first wild symbol is generated, the symbols are changed without spinning the reels. The specification regarding these figures discusses replacing or substituting symbols into a wild symbol. Moreover, since original claim 4 sets forth changing the symbols by spinning the reel, the application taken as a whole to one of ordinary skill in the art would clearly teach, especially in the case of video reels, that the symbols can be changed without spinning the reels.

Regarding the rejection of Claim 31, the Figures 5A to 11B of the application clearly show that the symbol replacement does not only have to occur after a winning combination is obtained in the first set. The specification describes the winning combination in Figure 5A. However, in regard to Figures 6A, 7A, 8A, 9A, 10A and 11A, no winning combination is discussed.

If the Examiner, upon further consideration, desires to maintain the rejections, Applicant respectfully request that the Examiner contact the undersigned to discuss and resolve these rejections.

The Office Action rejected Claims 1, 4, 7, 9, 10, 12, 13, 15, 17, 20, 22, 31, and 34 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,439,993 to O'Halloran ("*O'Halloran*"). Applicants have clarified the rejected claims to further distinguish over *O'Halloran* and respectfully disagree with and traverse this rejection.

Amended Claim 1 relates to a method for operating a slot machine including a plurality of reels and a plurality of symbols on the reels. Among other elements, the method includes randomly generating on a plurality of paylines associated with the reels a first set of the symbols from the plurality of symbols. The first set includes a plurality of symbols generated on each of a plurality of the reels, where each of the symbols in the first set of symbols is adapted for individual replacement. If a designated symbol occurs in the first set, said designated symbol causes a selection of all of the plurality of the symbols generated on the reel with the designated symbol being selected for individual replacement, and each selected symbol in the first set is individually replaced.

*O'Halloran* does not expressly or inherently disclose a designated symbol occurring in the first set causing a selection of all of the plurality of the symbols generated on the reel with the designated symbol being selected for individual replacement. Accordingly, amended Claim 1 and the claims that depend there from are in condition for allowance.

Claim 17 relates to a method for operating a gaming device including a plurality of reels and a plurality of symbols on the reels. Among other elements, the method includes generating a first set of the symbols on the reels, wherein one of the symbols in the first set is a first wild symbol which functions as one of the other symbols and causes a selection of all of the plurality of symbols generated on the reel of the first wild symbol in the first set for individual replacement. Each of the selected symbols is replaced with a second wild symbol to create a second set of symbols that is displayed in place of the first set of symbols.

*O'Halloran* does not expressly or inherently disclose generating a first set of symbols on a plurality of reels wherein the first wild symbol causes a selection of all of the plurality of symbols generated on the reel of the first wild symbol in the first set for individual replacement. For at least this reason, Applicants respectfully submit that Claim 17 and the claims that depend there from are patentably distinguished over *O'Halloran* and are in condition for allowance.

Amended Claim 31 relates to a method for determining an award in a slot machine including a plurality of reels, a plurality of symbols on the reels, and a plurality of award yielding combinations of the symbols. Among other elements, the method includes randomly generating on a plurality of paylines associated with the reels a first set of said symbols including a plurality of symbols on each of a plurality of reels. The first set is evaluated to determine if any award yielding symbol combinations are displayed and an award is provided to a player for each award yielding symbol combination appearing in the first set on any of the paylines. If a designated symbol occurs in the first set, the designated symbol causes a selection of a plurality but not all of the symbols in the first set is selected for individual replacement, wherein the selected symbols include at least two predetermined symbols on the reel of the designated symbol. Each selected symbol is individually replaced with one of the symbols to create a second set of symbols that is displayed in place of the first set of symbols.

*O'Halloran* does not expressly or inherently disclose that if a designated symbol occurs in the first set, the designated symbol causes a selection of a plurality but not all of the symbols in the first set is selected for individual replacement, wherein the selected symbols include at least two predetermined symbols on the reel of the designated symbol. For at least this reason, Applicants respectfully submit that amended Claim 31 is patentably distinguished over *O'Halloran* and is in condition for allowance.

Amended Claim 34 is directed to a slot machine. Among other elements, the slot machine includes a plurality of reels, a plurality of paylines with the reels, a plurality of symbols on the reels including a wild symbol functioning as at least one other non-wild symbol, and a plurality of symbol combinations that each yield an award. A processor controls the reels and causes the reels to generate a first set of the symbols along the paylines including a plurality of symbols on each of a plurality of the reels. If the wild symbol occurs in the first set, the wild symbol causes a substitution of one of the non-wild symbols in the first set with another wild symbol at each of the plurality of

generated symbols on the reel with the wild symbol to create a second set of symbols that is displayed in place of the first set of symbols.

*O'Halloran* does not expressly or inherently disclose that if the wild symbol occurs in the first set, the wild symbol causes a substitution of one of the non-wild symbols in the first set with another wild symbol at each of the plurality of generated symbols on the reel with the wild symbol to create a second set of symbols that is displayed in place of the first set of symbols. For at least this, Applicants respectfully submit that amended Claim 34 is patentably distinguished over *O'Halloran* and is in condition for allowance.

As stated in the previous response to office action,

- (i) the present invention is assigned to IGT, 9295 Prototype Drive, Reno, Nevada 89511, and was subject to an obligation of assignment to IGT at the time the invention was made;
- (ii) *O'Halloran* was subject to an obligation of assignment to I.G.T. (Australia) Pty Limited at the time the invention was made and is now assigned to I.G.T. (Australia) Pty Limited;
- (iii) I.G.T. (Australia) Pty Limited is presently, and was at the time both the invention of *O'Halloran* and the present invention were made, a wholly-owned subsidiary of International Game Technology, the parent corporation and owner of IGT; and
- (iv) accordingly, IGT and I.G.T. (Australia) Pty Limited are affiliated corporations which qualify under 35 U.S.C. § 103(c) and *O'Halloran* is not prior art under 35 U.S.C. § 103(c).

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the undersigned.

Respectfully submitted,

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